

REMARKS

Claims 1-19 are presented for further examination. Claims 1-3, 7, 11, 13, 16, and 17 have been amended.

In the Office Action mailed November 29, 2002, the Examiner objected to the specification because of informalities on page 15. Applicant has corrected the informalities noted by the Examiner on page 15.

The drawings were objected to because Figures 1 and 3-10 should be designated by a legend such as "Prior Art." The drawings were also objected to because reference numerals 120 and 122 were not indicated as described in the specification. Applicant has amended Figures 1 and 3-11 to add the legend and the reference numbers as requested by the Examiner.. Applicant is submitting herewith substitute formal drawings along with a courtesy copy for the Examiner showing the changes highlighted in yellow. Applicant respectfully requests that the changes be approved and the substitute formal drawings be entered in this case. Applicant notes that Figure 1 is described in the specification as showing one embodiment of the invention, and hence it should not be labeled as "Prior Art."

Claims 1, 11, 13, and 17 were objected to because of informalities that applicant has corrected in the foregoing amendment. Claims 13 and 17 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. The foregoing amendments overcome this rejection.

Turning to the merits, claims 1-6, 11-15, and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 317,188 ("Pederson") in view of U.S. Patent No. 2,522,908 ("Szabo"). Claims 7-10, 15, 16, 18, and 19 were rejected as obvious over U.S. Patent No. 5,105,551 ("McCutchen et al.").

Applicant respectfully disagrees with the bases for the rejections and requests reconsideration and further examination of the claims.

The disclosed and claimed embodiments of the invention are directed to a tool for use in measuring and marking material. The tool is formed of a transparent sheet of rigid material and a sheet of non-static cling, flexible material adhered to one side of the transparent sheet of rigid material. Lines may be formed on one of either the rigid material, the flexible material, or both. It is important that both sheets of material permit viewing to the combination

thereof for measuring and marking material, such as fabric on which the tool is placed. This is a  
\* critical feature that if not present would defeat the purpose of the tool. Another important feature  
is the adhering of the flexible sheet to the rigid sheet in a manner that permits it to be easily  
removable and that does not attract or retain dust, lint, dirt, and the like. This is very important  
when working with fabric material where loose lint and fibers can easily be pulled from the  
material if adhesive or static cling material were used. (See specification at page 2, lines 18-20.)  
In addition, the surface presented by the flexible material when placed against the underlying  
material should be smooth so as to prevent catching of the flexible material on the underlying  
material, as discussed at page 2, lines 10-12 and 18-20 of the present application.

Pederson, U.S. Patent No. 317,188, is directed to an elongate ruler having a top  
surface and a bottom surface with the bottom surface provided with "diagonal lines cut into the  
body of the ruler, whereby the said ruler is roughened to prevent slipping when applied to a  
polished or hard surface . . . ." (See Pederson, column 2, lines 70-74.)

Szabo, U.S. Patent No. 2,522,908, discloses a non-transparent ruler similar to that  
of Pederson, except a band of resilient, non-slipping material is secured by adhesive or the like in  
a groove 16 formed adjacent one edge of the bottom surface of the ruler. This material is non-  
transparent, and is described as eraser material. Szabo does not teach or suggest the band of non-  
\* slipping material being removably attached to the ruler or the use of transparent material.

McCutchen et al., U.S. Patent No. 5,105,551, is directed to a template having  
cutouts with a buffer element "permanently attached" thereto to provide protection to cutouts  
formed in the template when ink is deposited on a drawing surface on which the template is  
placed. McCutchen clearly teaches permanent attachment of the buffer strips to the template  
(see column 3, lines 6-7) and does not teach or suggest the buffer elements being made of  
transparent material. Rather, the buffer elements are made of the same material that is used for  
the manufacture of erasers (see McCutchen et al., column 3, lines 31-32). Moreover, McCutchen  
et al. teaches the use of parallel strips for trapping an air cushion to allow "easier template  
movement over the drawing surface" (see column 3, lines 28-30). In addition, McCutchen et al.  
teaches the addition of "a weak adhesive to the surface of either the planar or strip buffer  
elements" which "would reduce the tendency of slick plastic templates to slip as the draftperson

holds them in place.” This is clearly inapposite to the present invention which seeks to avoid the use of adhesive because of the tendency to collect lint, fiber, dirt, and the like on the surface, which would tend to reduce the transparency thereof and allow or facilitate the transfer of such dirt to the surface of the material on which the tool is placed.

Turning to the claims, claim 1 is directed to a tool for use in measuring and marking material that comprises a transparent sheet of rigid material and a transparent sheet of non-static cling flexible material sized and shaped to cover the entire first side of the sheet of rigid material which is removably adhered to the first side of the first sheet of rigid material with surface adhesion to provide a removable, non-slip surface when placed against material. Clearly, the combination of Pederson and Szabo fails to teach or suggest to one of ordinary skill the combination recited in claim 1. Moreover, such combination lacks transparency, and it lacks the use of non-static cling, flexible material, removably adhering the flexible material to the transparent sheet of rigid material to cover the entire first side of the sheet of rigid material.

The Examiner dismisses these distinguishing limitations as merely “preferred” or “optimum” without a showing of criticality, or that these are alternative types of surfaces that will perform the same function. Applicant respectfully disagrees. As the specification makes clear, the present invention is for use in measuring and marking material over which the tool is applied. The lines formed on the tool create a gridwork over substantially the entire surface of the tool and not along just one edge as the references teach. Thus, it is critical that the tool be transparent so that underlying material can be measured for marking and cutting.

The flexibility of the non-static material applied to the rigid sheet of material is important because, among other reasons, it enables or facilitates easy peeling of the flexible sheet off the rigid sheet of material. Moreover, surface adhesion using non-static cling rigid material is not as strong as that achieved with flexible material, and hence the use of flexible material is ideal for the present invention.

The removability of the flexible sheet is important because a key feature of the invention is to not damage the tool (see specification at page 3, lines 11-10). The rigid sheet of material having lines formed thereon can be quite expensive to manufacture and purchase, and attaching the flexible sheet thereto in a manner that causes damage to the rigid sheet when the

flexible sheet is removed is not functionally or commercially acceptable. Moreover, interchangeability of the flexible sheet between rigid sheets or other rulers is another important feature (see specification at page 4, lines 15-16 and 20-22). For example, using a marker to mark the flexible sheet for a particular project, as described in the specification, would ruin the rigid sheet for future use unless the marked-up flexible sheet could be easily removed and replaced.

For all of the foregoing reasons, applicant respectfully submits that claim 1 is allowable over the references cited and applied by the Examiner.

Claim 2 is directed to another embodiment of the invention wherein a plurality of sheets segments are placed together on the first side of the sheet of rigid material to form a sheet of flexible material having a planar surface for bearing against the underlying material. Applicant respectfully submits that claim 2 is allowable for the reasons why claim 1 is allowable.

Independent claims 3, 11, and 15 include limitations similar to claim 1, and these claims, as well as their associated dependent claims are allowable for the reasons discussed above with respect to claim 1.

Claim 7 is directed to a method of making a transparent tool for use with measuring marking material that comprises providing a transparent sheet of rigid material having first and second opposing planar sides in a plurality of lines formed on one of the first and second opposing planar sides; providing a transparent sheet of non-static cling, non-slip flexible material; sizing the sheet of flexible material to substantially cover only one of the first and second opposing planar sides of the sheet of rigid material; and placing the sized sheet of flexible material on only one of the first and second opposing planar sides of the sheet of rigid material to substantially cover only the one side of the sheet of rigid material and to provide a removable non-slip bearing surface when placed on the material.

McCutchen et al., the reference cited against claims 7-10, 15, 16, 18, and 19 teaches a buffered inking template that has a rubber strip buffer element made of eraser material (hence non-transparent) permanently attached to a template by adhesive. A weak adhesive can be applied to the buffer element to produce a tack surface when applied to drawing paper. Clearly, McCutchen et al. is not concerned with attracting lint, fiber, dirt, and other foreign substance associated with fabric material because he utilizes adhesive to produce a tack surface

for bearing against the drawing paper or drafting surface. Applicant respectfully submits that claim 7 as well as dependent claims 8-10, independent claim 15 and dependent claims 16-18, and claim 19 are clearly allowable over McCutchen et al.

In view of the foregoing, applicant submits that all of the claims in this application are in condition for allowance. In the event the Examiner finds minor informalities that can be resolved by telephone conference, the Examiner is urged to contact applicant's undersigned representative by telephone at (206) 622-4900 in order to expeditiously resolve prosecution of this application. Consequently, early and favorable action allowing these claims and passing this case to issuance is respectfully solicited.

The Commissioner is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

Randal D. Schafer

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ERT:aep

Enclosure:

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